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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,500	12/12/2003	Demetrius Bagley .	02700-0711	1614

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EXAMINER

POUS, NATALIE R

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/734,500	BAGLEY ET AL.	
	Examiner	Art Unit	
	Natalie Pous	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-32 is/are pending in the application.
- 4a) Of the above claim(s) 15, 16 and 25-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/3/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Remarks

Terminal Disclaimer

The terminal disclaimer filed on 3/3/06 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 6676668 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Examiner withdraws the prior statutory and non-statutory double patenting rejections.

Examiner further acknowledges the cancellation of claims 1-14, and the addition of claims 17-32. Claims 15 and 16 are withdrawn from consideration as they depend from cancelled claim 10.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 17-24, drawn to apparatus, classified in class 606, subclass 127.
- II. Claims 25-32, drawn to method of use, classified in class 128, subclass 898.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of

using that product. See MPEP § 806.05(h). In the instant case (2) the product as claimed in the evidence claim (claim 17) does not require a rotating step, and thus the device may be used in a materially different process, such as one only requiring linear movement of the basket.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Newly submitted claims 25-32 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the original claims (1-16) were drawn to a device.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 25-32 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 17 –24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rydell (US 5613942) in view of Bates et al. (US 6174318).

Rydell teaches the following:

- a basket (30)
- and an actuator (132) coupled to the operating elements (202),
- the actuator being configured to simultaneously move both operating elements in the same direction (34)
- and the actuator being separately capable of simultaneously moving the operating tubes in opposite directions (208)
- a sheath(124), wherein the operating elements extend along an axis of the sheath
- the basket (30) coupled to the operating elements (202) at a distal end of the sheath (126)
- the actuator coupled to the operating element at the proximal end of the sheath (fig. 4)

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- the actuator is configured to move both operating elements along the axis of the sheath in a forward direction toward the basket and a rearward direction away from the basket (along guide slot 150)
- each leg of basket (28) is connected to operating element
- the actuator (132) is configured to rotate the basket by moving the operating tubes in opposite directions (Column 6, proximate lines 20-30)
- the actuator (132) is configured to translate along a first axis (150) to simultaneously move both operating elements in the same direction
- the actuator is configured to rotate (146) about a second axis to simultaneously move the operating elements in opposite directions (Column 6, proximate lines 20-30)
- the actuator comprises a slide (132) and a wheel (146)
- the slide configured to translate such that both operating elements (202) move in the same direction and the wheel configured to rotate such that the operating elements move in opposite directions (Column 6, proximate lines 20-30)

Rydell fails to disclose the following

the basket having at least three legs

two of the legs being coupled to a first operating tube

and one of the legs being coupled to a second operating tube

the operating tubes being coupled to the actuating mechanism

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Bates teaches a retrieval device comprising a basket having at least three legs (28, 30, 32), two of the legs (30, 32) being coupled to a first operating member (23); and one of the legs (28) being coupled to a second operating member (22), and the operating members being coupled to the actuator (fig. 1b) in order to cause the leg 28 to extend further from sheath 14 than the other basket legs 30, 32 and 34, thereby forcing leg 28 to bend outward and altering or tilting the shape of the expanded basket 10 into an extended, open position and improve retention of captured material in the basket. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Rydell as taught by Bates in order to enable the device to tilt into an open basket shape and improve retention of captured material in the basket.

Regarding the limitation requiring operating tubes, Rydell teaches wherein elongate members are connected to the basket (30) and to the actuator (132). It would have been an obvious matter of design choice to modify the elongate members of Rydell with tubes as disclosed by the applicant, since the applicant has not disclosed that tubes provide any advantage over solid members, or are for any particular purpose, and it appears that the elongate members of Rydell perform the task of actuating the basket equally well as that disclosed in the application.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims

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are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 17-32 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6652537.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they relate to the same inventive concept, and comprise a majority of the same limitations.

For instance, both call for a method and apparatus for medical retrieval device comprising basket having at least three legs, wherein the legs are attached to tubes, which are movable both in the same direction and opposite directions inside a sheath. Both further comprise both a rotational and translational actuating means.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie Pous whose telephone number is (571) 272-6140. The examiner can normally be reached on Monday-Friday 8:00am-5:30pm, off every 2nd Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NRP
5/22/06


(JACKIE) TAN-UYEN HO
PRIMARY EXAMINER
5/20/06